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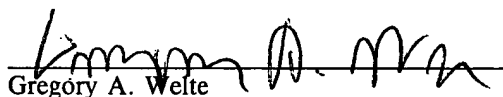
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF APPEALS

Assignee's Docket No.: 9137.00)
)
Group Art Unit: 3264)
)
Serial No.: 09/522,085)
)
Examiner: Jeffrey Pwu)
)
Filing Date: March 10, 2000)
)
Title: Self Service Terminal)
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APPEAL BRIEF
A Summary of Argument Begins on Page 3

CERTIFICATE OF MAILING

I certify that this document is addressed to Mail Stop AF, Commissioner of Patents, PO Box 1450, Alexandria, VA 22313-1450, and will be deposited with the U.S. Postal Service, first class postage prepaid, on November 8, 2004.


Gregory A. Welte

The fee for this Brief may be billed to Deposit Account 14 - 0225, NCR Corporation.

1. REAL PARTY IN INTEREST

NCR Corporation.

2. RELATED APPEALS AND INTERFERENCES

None.

3. STATUS OF CLAIMS

Claims 1 - 8 and 15 - 31 are pending, rejected, and appealed.

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4. STATUS OF AMENDMENTS

No Amendments-After-Final have been submitted.

5. SUMMARY OF INVENTION

Figure 2 of the Specification shows an Automated Teller Machine, ATM. Ordinarily, a user utilizes a keypad 28 and a display screen 26 to interact with the ATM to, for example, withdraw cash. See Specification, page 9, lines 4 - 7, and page 1, lines 8 - 11.

In one form of the invention, a modification is undertaken to the ATM. As described in the Specification, page 10, line 1 et seq., a transceiver 92 is added to the ATM, and new, or additional, software is installed. The transceiver 92 can take the form of an adapter card, which is installed in a vacant slot in the computer. (Specification, page 13, lines 9 - 12.)

With this modification, the ATM can respond to instructions issued from a wireless telephone. For example, a customer can use a wireless telephone to instruct the ATM to dispense cash. The use of a wireless telephone can be desirable from a security aspect, and from a personal preference aspect, as explained in the Specification, page 1, lines 17 - 24.

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6. ISSUES

Whether claims 1 - 8 and 15 - 31 are obvious under 35 USC § 103, based on Suer and Terranova.

7. GROUPING OF CLAIMS

A single group of claims is present, namely, claims 1 - 8 and 15 - 31. No claims stand or fall together in this group, with the exception of claim 5.

8. ARGUMENT

SUMMARY OF ARGUMENT

All rejections are obviousness type, and rely on two references: Suer and Terranova.

Terranova Reference not Available.

Terranova is a published US application, having a publication date of November 29, 2001. Appellant's filing date precedes that date, and is March 10, 2000.

Consequently, the Terranova reference is not available, and the rejections cannot stand.

Content of Some Claims Never Shown in References

The following claim recitations have NEVER been identified, or even asserted present, in the applied references.

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Claim 24: "the transceiver is assigned a telephone number, and the [ATM] displays that telephone number to customers." Neither the "telephone number" nor the "display" of that number have been shown in the references.

Claim 2: "retro-fitting an ATM with" a specific computer program. Neither the "program" nor the "retro-fitting" have been shown or asserted present.

Claim 21: a program on a "host," is upgraded, a program on an ATM is upgraded, or both programs are upgraded. Neither type of upgrading has been shown in the references.

Claim 30: "the transceiver comprises an adapter card installable in a computer." No such adapter card has been shown in the references.

MPEP § 2143.03 states:

To establish prima facie obviousness . . .
all the claim limitations must be taught or suggested by the prior art.

The rejections of these claims fail to comply with this MPEP section. All claim elements must be shown in the applied references, and that has not been done.

"Wireless Telephone" not Shown in References

All claims, except possibly claims 16 and 19 and their dependents, recite a "wireless telephone."

Suer is cited to show a "wireless telephone," but no such

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telephone is found in Suer. No "wireless telephone" has been shown in the applied references, as required by the MPEP section cited above.

Suer discusses using a hand-held computer to communicate with an ATM. (Column 4, lines 30 - 34.) He gives a PDA, Personal Digital Assistant, as an example. (Column 2, line 47 et seq.)

A hand-held computer is a completely different device from a wireless telephone, and performs completely different functions.

Suer does not show the claimed "wireless telephone."

Issuance of Commands by "Wireless Telephone" not Shown

Since no "wireless telephone" has been shown in the references, the claimed issuance of "commands" by a "wireless telephone" has also not been shown. Independent claims 1, 8, 15, 17, and 20 recite such issuance.

Rationale for Combining References is Factually Incorrect

The rationale used by the PTO is this:

[It is obvious] to equip an ATM that [lacks]
. . . the remote control communication system
by using [S]uer's device to communicate via a
transponder/receiver as taught by Terranova
to conduct business wirelessly.

(Final Action, page 3.)

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This rationale employs incorrect facts, or makes no sense.

The rationale asserts that Suer's device should be used to communicate as Terranova teaches. But Suer shows an ATM communicating with a portable computer. Terranova shows nothing of the sort.

Thus, it is **impossible** to use Suer's device "as taught by Terranova."

**Rationale for Combining References is Utterly Conclusory
And Thus Invalid**

The rationale was quoted immediately above. This rationale is verbose and redundant, and can be simplified to this:

It is obvious to equip an ATM lacking
wireless remote control by using Suer's
remote control as taught by Terranova.

Plainly, this fails to qualify as a teaching under section 103. It is an utterly conclusory statement. No evidence has been given in support of this rationale.

The CAFC, in the Dembiczak decision, discussed herein, prohibits conclusory statements.

Rationale Does not Support its Conclusion

The rationale sets forth a premise, and a conclusion. The premise is this:

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PREMISE: Terranova teaches using Suer's
remote control.

Assuming the premise to be correct, Appellant asks the reader to
supply a conclusion which logically follows from the premise:

CONCLUSION: _____

The conclusion reached by the Final Action is that an ATM
lacking a remote control should be supplied with Suer's remote
control.

Does that follow from the premise, as a matter of logic ?
No.

Rationale for Combining References does not Lead to Invention

Even if the PTO's rationale, cited above, be accepted, it
does not actually lead to the claimed invention.

The rationale asserts that wireless remote control should be
added to an ATM. But the claims do not state that.

The claims recite using a "wireless telephone" to cause an
ATM to dispense cash. That is, the claims recite a specific type
of remote control. The PTO's rationale does not suggest that,
but only suggests a generalized remote control.

Claimed Modification of ATM not Shown in References

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Several independent claims recite modifying an ATM or Self Service Terminal (SST) to allow it to accept commands from a "wireless telephone." (See, for example, claims 1, 8, 15, 17, and 20.) Suer is cited to show this.

However, these claims state that a functioning non-modified ATM/SST exists prior to the modification, and is then modified. Those two elements (functioning non-modified ATM and the later modified ATM) have not been shown in Suer.

One Possible Interpretation of Suer by PTO

The PTO may be treating an ATM which is undergoing its initial manufacturing process as the non-modified ATM of the claims. But several problems exist in this interpretation.

PROBLEM 1

Claim 1 recites "identifying an ATM" having certain characteristics. Under the claim language, that ATM is an **operative** ATM. For example, it "has a screen for displaying options for withdrawing cash and a touch input mechanism for receiving user commands" as in claim 1.

Any ATM-under-manufacture in Suer is not operational, as required by the claim language.

This applies to claims 8, 15, and 20.

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PROBLEM 2

The claims in question indicate that

- 1) an operational ATM/SST is present which
- 2) is **modified** to thereby acquire new properties.

For example, it is modified to accept commands from a "wireless telephone."

These two elements are not present in Suer. There is no **operational** ATM which is then **modified** as claimed.

Another Possible Interpretation of Suer by PTO

It is possible that the PTO is treating an ordinary ATM as discussed in Suer's prior art as the non-modified ATM of the claims. However, Suer does not suggest modifying such ATMs.

Suer suggests manufacturing a different type of ATM, namely, one which conforms to Suer's suggestions.

That does not show the claims.

Comment

Not all points in this Summary are elaborated below. Some are considered self-explanatory.

END SUMMARY

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ARGUMENT
RESPONSE TO REJECTION OF CLAIMS IN GROUP 1
Content of Claims not Shown in References

Point 1

MPEP § 2143.03 states:

To establish prima facie obviousness . . .
all the claim limitations must be taught or
suggested by the prior art.

The Final Office Action has failed to identify

- 1) the elements of each claim and
- 2) the recited inter-relationships of those
elements

in the applied references.

Instead, the Final Action, beginning on page 2, section 2,
sets out its summaries of various passages in Suer.

That is insufficient. Twenty-five claims are pending.
Every claim must be shown in the prior art. A summary of parts
of a reference, in general, does not operate to show "all claim
limitations" as required by the MPEP section cited above.

Point 2

The Final Action sets forth seven paragraphs (pages 2 and 3)
which purport to summarize various aspects of Suer. However, the
Final Action makes no connection between those paragraphs and the

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claims.

Therefore, it is unclear which of those seven paragraphs are intended to apply to each claim.

Again, all claim limitations have not been shown, as required by the MPEP section cited above.

Point 3

37 CFR § 1.104(c)(2) states:

. . . the Examiner must cite the best references at his . . . command.

When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable.

The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

The Final Action has failed to comply with this regulation.

Each claim must be individually rejected. The Final Action has failed to identify which parts of Suer are being relied on for each claim.

Final Action's Summaries of Suer are Incorrect

**Appellant's Description of Passages
In Suer Cited by Final Action**

The Final Action, pages 2 and 3, sets forth seven

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paragraphs, each preceded by an arrowhead, which purport to summarize various aspects of Suer.

Several of those paragraphs repeatedly cite the same passages in Suer as support, but all of those paragraphs rely on the following sections of Suer:

- 1) column 1, lines 13 - 15;
- 2) almost all of columns 3, 4, and 13;
- 3) the first seventeen lines of column 14;
- 4) element 63 in Figure 2A; and
- 5) steps 161 - 162 in Figure 6.

Appellant will briefly describe the content of those sections. For reference, Appellant will divide some of these sections into ITEMS.

Suer, Column 1, Lines 13 - 15 (ITEM A)

This passage refers to "storing" a "financial transaction" in a "portable unit" for later transmission to a "terminal unit, such as . . . an . . . (ATM) "

Suer, Column 3, Line 9 - Column 4, Line 65 (ITEMS B - J)

ITEM B

Column 3, lines 9 - 31 (ITEM B) state that, once a user has stored financial information in a "handheld unit," he can transfer the information to an ATM or PC. Suer states that

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transfer to a PC has the advantages that the PC has more processing- and storage power, and can also be connected to other PCs through networks.

ITEM C

Column 3, lines 32 - 45 (ITEM C) state that some types of handheld units can transfer data to PCs, but that the transfer process is awkward.

ITEM D

Column 3, lines 46 - 50 (ITEM D) state that an object of Suer's invention is to transfer data from handheld units in a convenient manner.

ITEM E

Column 3, line 54 - column 4, line 7 (ITEM E) describes Suer's invention as including a hand-held unit which stores financial data, and also captures hand-written images, and stores them as bit-maps, such as the hand-written image of a bank check.

ITEM F

Column 4, lines 8 - 17 (ITEM F) state that the hand-held unit may contain an accounting program.

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ITEM G

Column 4, lines 18 - 29 (ITEM G) state that (1) since handwriting is captured, an alphanumeric keyboard is not necessary and (2) the device automatically inserts a date and check number for each check.

ITEM H

Column 4, lines 30 - 42 (ITEM H) state that the hand-held device can use an infra-red link to communicate with a PC or ATM.

ITEM I

Column 4, lines 43 - 59 (ITEM I) state that the hand-held device can also be used to transfer data to a point-of-sale device (eg, a cash register) in connection with a purchase.

ITEM J

Column 4, lines 60 - 65 (ITEM J) state that certain types of encryption are undertaken in transfer of data from the hand-held unit.

Column 13, line 17 - Column 14, Line 17 (ITEMS K - N)

ITEM K

Column 13, lines 17 - 40 (ITEM K) now call the hand-held device an "information storage device." (See column 6, lines 42

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- 45.) Appellant will use the term "hand-held device." This passage, in essence, states that the hand-held device identifies itself to a PC, and transfers data to the PC. This passage does not state that the hand-held device transfers to a generic terminal, but only refers to a PC.

ITEM L

Column 13, lines 41 - 54 (ITEM L) describe Figure 8, which shows the structure of a data packet used in the data transfer described in the paragraph immediately above this paragraph.

ITEM M

Column 13, lines 55 - column 14, line 6 (ITEM M) further describe the contents of the data packet of Suer's Figure 8. The contents are typical of a financial transaction, and refer to a check number, date, amount, and so on.

ITEM N

Column 14, lines 7 - 17 (ITEM N) state that the data packet of Figure 8 is given a special name, for easy retrieval, and that, after the data packet is loaded into the PC, it is copied for various purposes.

Suer's Element 63 in his Figure 2A (ITEM O)

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Element 63 is a button on a hand-held device labeled "withdrawal." Apparently this is used to withdraw money from an ATM, for example. (See column 6, lines 53 - 55.)

Suer's Steps 161 and 162 in his Figure 6 (ITEM P)

Elements 161 and 162 are not steps at all. They are a "pulse shaper" and a "driver." Those are components of the infra-red communication system which Suer discusses. (See column 10, lines 58 - 64.)

Analysis of Final Action's Summaries

Appellant will now analyze the seven paragraphs of the Final Action on pages 2 and 3, which are preceded by arrowheads. These seven paragraphs assert that Suer shows selected claim elements, and rely on the ITEMS described above to support the assertions.

FIRST SUMMARY PARAGRAPH

Point 1

The first-summary-paragraph of the Final Action (that beginning with "identifying an ATM (SST) . . ." and appearing on page 2, section 2) asserts that Suer shows

-- "identifying an ATM" having particular
characteristics
and

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-- "modifying said ATM to enable it to
receive from a wireless telephone user
commands for dispensing cash."

The Final Action relies on ITEMS E through H, K, and O,
listed above, to show this. However, these ITEMS do not show
this.

None of those ITEMS discuss "modifying" and ATM. Nor can
Appellant find any discussion in Suer of modifying an ATM as
claimed.

Further, the PTO s first-summary-paragraph asserts that Suer
shows modifying an ATM to allow a wireless telephone to order the
ATM to dispense cash. This assertion is contrary to an assertion
on page 3 of the Final Action, which states:

However, Suer fails to show a wireless phone
to withdraw cash from an ATM.

Therefore, the Final Action is defective. Contradictory
statements cannot be used.

Point 2

From the moment Suer begins describing his invention, he
pre-supposes that ATMs are available for his hand-held device to
order to dispense cash. (Column 6, line 49 et seq.)

Consistent with this, Appellant find no discussion in Suer

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stating that an existing ATM which is involved in Suer's invention lacks the capability of dispensing cash in response to the hand-held device.

Thus, Suer does not discuss modifying existing ATMs to accommodate his own hand-held devices. Therefore, it makes sense that he does not discuss modification of ATMs to respond to wireless telephones.

Restated, he performs no modifications of ATMs.

Point 3

If Suer discusses **modifying** an ATM, then he must show, or discuss, a **non-modified** ATM. But no **non-modified** ATM has been identified in Suer, let alone a non-modified ATM which is then modified as claimed.

Point 4

The first-summary-paragraph states that Suer creates modifications allowing a wireless telephone to get cash from an ATM. But no wireless telephone is mentioned in the ITEMS used by the PTO to support its first-summary-paragraph.

Thus, the first-summary-paragraph must be incorrect.

Conclusion

The Final Action's first-summary-paragraph of Suer (that

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beginning with "identifying an ATM (SST) . . ." and appearing on page 2, section 2) is factually incorrect.

-- None of the passages in Suer cited by that summary-paragraph refer to **modifying** an ATM.

-- Suer always assumes that an ATM is available for his hand-held device, thereby militating against a desire for modifying an ATM.

-- Suer does not discuss "wireless telephones" which get cash from ATMs, nor wireless telephones at all.

The first-summary-paragraph is factually incorrect.

SECOND SUMMARY PARAGRAPH

The second-summary-paragraph states:

wherein said transceiver is further adapted to transmit signals directly to said wireless telephone.

This summary-paragraph cites ITEMS F - J above in support of its propositions.

Problem

Appellant first points to a problem with this summary-

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paragraph. Taken by itself, this summary paragraph has no relevance to any of Appellant's claims. That is, no claim recites a generalized transceiver which communicates with a wireless telephone. In all claims, the recited "transceiver" is associated with an ATM. Thus, insofar as the summary-paragraph refers to a generalized transceiver (such as one associated with Suer's PC), the summary-paragraph is irrelevant.

Therefore, the term "wherein" must mean that the second-summary-paragraph is referring to a transceiver located in the ATM of the first-summary-paragraph. If such a transceiver is not meant, then, again, the second-summary-paragraph is irrelevant.

Point 1

An examination of the ITEMS used to support the summary-paragraph clearly indicates that no support is present. Suer shows no transceiver which transmits signals to a wireless telephone.

Point 2

The second-summary-paragraph asserts that a "transceiver" in Suer's ATM transmits signals "TO said wireless telephone." This assertion must be incorrect, as an engineering matter.

The reason is that the only possible transceiver in the ITEMS cited by the PTO is an **infra-red** transceiver. That cannot

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show a wireless telephone.

It is well known that wireless telephones do not use infra-red light as a carrier. One reason is atmospheric absorption: water vapor, carbon dioxide, or both, in the atmosphere absorb infra-red radiation. Appellant offers to submit an affidavit on this point, if the Board requests.

A second reason is that infra-red transmission requires line-of-sight travel. Infra-red light does not travel through buildings, as does radio-frequency radiation, which is used by cell phones. Thus, wireless telephones using infra-red radiation are not used, consistent with their absence from Suer.

In addition, and independent of the two reasons just given, a wireless telephone using infra-red radiation has not been shown in Suer. That is,

- the second-summary-paragraph asserts that Suer's "transceiver" transmits signals to a "wireless telephone,"
- but the only transceiver present is an infra-red transceiver,
- thus, an infra-red wireless telephone must be shown.

But no infra-red wireless telephone has been shown in the ITEMS used to justify the second-summary-paragraph.

The second-summary-paragraph is not supported by Suer.

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THIRD SUMMARY PARAGRAPH

The third-summary-paragraph states:

wherein said signals implement local wireless communication.

It is not clear what "said signals" refer to. If "said signals" refer to the supposed infra-red wireless telephone, then, as just explained, the "said signals" do not exist.

Further, this summary-paragraph is not dispositive. The claims do not recite the mere existence of "local wireless communication."

FOURTH SUMMARY PARAGRAPH

The fourth-summary-paragraph asserts that "said modifying step includes providing a connection between said network and said wireless device."

Problem 1

One problem with this summary-paragraph is that it is irrelevant to the claims. No claim recites a connection "between said network" and a "wireless device."

Problem 2

A second problem is that the summary-paragraph is vague and indefinite. It refers to "said wireless device," but at no location in the PTO's discussion is "said wireless device" identified.

FIFTH SUMMARY PARAGRAPH

Point 1

The PTO's fifth-summary-paragraph refers to "said modifying step." Presumably, this modifying step is that mentioned in the PTO's first-summary-paragraph, in the phrase "modifying said ATM to enable it to receive from a wireless telephone user commands for dispensing cash."

However, as explained above, no such modifying step is found in the references.

Point 2

The PTO's fifth-summary-paragraph relies on Suer's steps 161 and 162 in his Figure 6 to show this supposed modification. However, as explained above (Appellant's ITEM P), elements 161 and 162 are not steps at all. They are a "pulse shaper" and a "driver." Those are components of the infra-red communication system which Suer discusses.

Thus, Suer's components 161 and 162 do not show the claim

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elements for which the PTO cites the components.

Point 3

The PTO's fifth-summary-paragraph states that the supposed newly installed "transceiver" in Suer is connectable to the system bus of a computer, and cites ITEM H (ie, Suer, column 4, lines 30 - 42) as showing this.

However, as explained above, ITEM H states that Suer's hand-held device (which is not a telephone) can use an infra-red link to communicate with a PC or ATM.

-- ITEM H discusses no newly installed
"transceiver."
-- ITEM H fails to state that any
"transceiver" is connected to the "system
bus" in a computer.

ITEM H of Suer states that the IR adapter is connected to "the terminal unit's serial, parallel, Universal Serial Bus (USB) or IrDA port." None of those elements qualify as the "system bus."

Explanation of "System Bus"

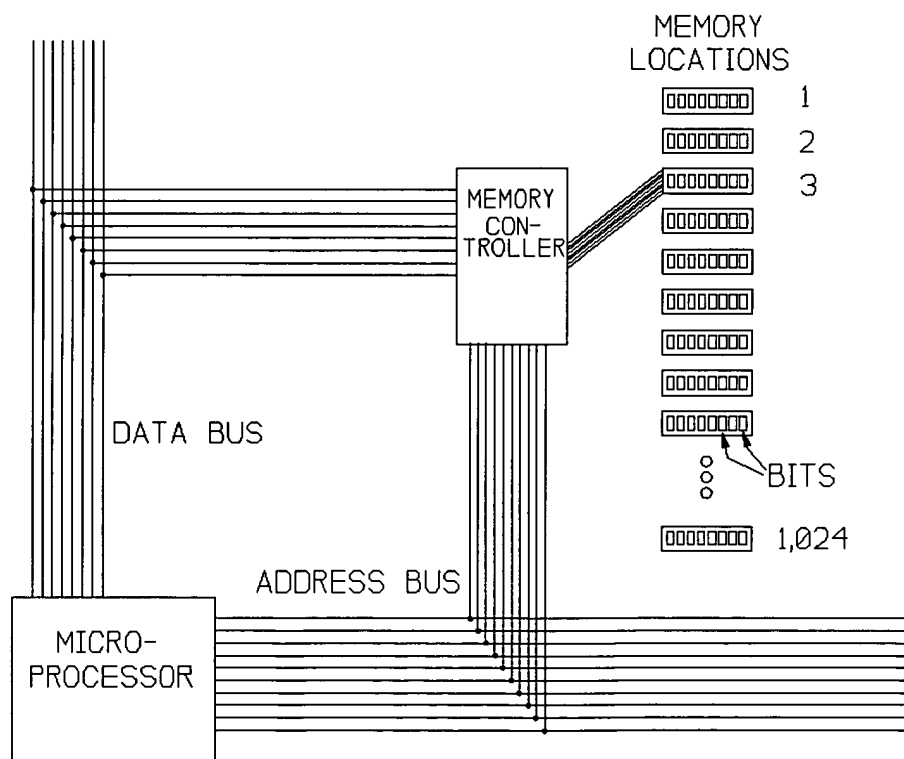
If you open a PC, you may see so-called "adapter cards," such as a sound card, a video adapter, or a joystick card. In modern PCs, such cards are becoming extinct, because the

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functions of the cards are being included in the motherboard. Nevertheless, in the IBM PC architecture, slots are still manufactured to accept such cards.

These slots connect to the "system bus." As one example of an implementation of Appellant's invention, the "transceiver" can be manufactured as an adapter card, which is inserted into one of these slots, which connect to the system bus.

Sketch 1, below, will explain the concept of a "system bus."



SKETCH 1

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Sketch 1 shows 1024 MEMORY LOCATIONS, each location storing eight bits (one byte). A DATA BUS containing eight lines is shown, one for each of the eight bits. An ADDRESS BUS is shown, containing 10 lines. Each line carries either a high voltage (ie a logic ONE) or a low voltage (ie, a logic ZERO). In order to provide 1024 unique combinations of addresses, to address each of the 1024 MEMORY LOCATIONS, ten address lines are required. Restated, 2-raised-to-the-tenth power equals 1024.

Assume that the MICROPROCESSOR wants to read the contents of memory location 3. The processor first places a "3" in binary format onto the ADDRESS BUS, namely, the binary number 0000000011.

Then the MICROPROCESSOR puts a signal on a control line (not shown), telling the MEMORY CONTROLLER that the MICROPROCESSOR is asking for data. The MEMORY CONTROLLER then connects to memory location 3, as indicated by the eight slanted lines, and places the eight bits of data in memory location 3 onto the DATA BUS.

Then the MEMORY CONTROLLER puts a signal on another control line (not shown), telling the MICROPROCESSOR that the data is now ready on the DATA BUS. The MICROPROCESSOR then accepts the data on the DATA BUS.

The address bus, data bus, and the control lines are commonly called the "system bus."

The system bus also connects to other items, such as a disc

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drive controller. This allows the processor to read, and write, data from, and to, a disc drive, as by specifying, in effect, cylindrical coordinates on the disc where the data is to be found, or placed.

Claimed System Bus Connection
Not Shown in Suer

POINT 1

As explained above, Suer states that his infra-red communication is done using "serial, parallel, Universal Serial Bus (USB) or IrDA port." None of those qualify as the "system bus."

Those elements may connect to a system bus. But the claim does not recite that.

From another perspective, ITEM H in Suer states that the infra-red transmitter is connected to the "serial, parallel, Universal Serial Bus (USB) or IrDA port" of Suer. Even assuming arguendo that one of those ports connect directly with a system bus, that does not show the claimed connection.

The claim language is that a transceiver connects to a "system bus." At best, Suer shows an infra-red transceiver, which connects to a "port," which "port" may connect to a system bus.

But his "transceiver" does not connect to the "system bus."

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His "port" does.

POINT 2

A "system bus" is a completely different entity from the ports mentioned in Suer, column 4, lines 30 - 42. One reason is that, in general, a computer can exist, and perform computation, without those ports.

For example, a word processor operating on a PC can operate with no trouble at all without serial ports or parallel ports. Printing on a printer may not be possible, but that can be remedied by copying the document to a diskette, and printing elsewhere.

However, if a "system bus" were absent, the PC could not operate at all.

Restated, the "system bus" is a necessary part of the computer, and is necessary for the microprocessor to operate. That is not so with Suer's ports.

They do not correspond to the recited "system bus."

Conclusion as to Fifth Summary Paragraph

The PTO has not shown in Suer

- a "transceiver" for communicating with a "wireless telephone;"
- that "transceiver" being connected to a

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"system bus;" nor
-- the claimed modification step of
installing the transceiver.

In connection with the very last element (the modification step), Appellant points out that, if the modification step is to be found, then an **unmodified** ATM must be shown in the reference.

That has not been done.

SIXTH SUMMARY PARAGRAPH

The sixth-summary-paragraph asserts that

-- a self-service terminal has been retro-
fitted to allow the terminal to execute
transactions entered using a wireless
telephone

and

-- prior to retro-fitting, the wireless
telephone could not execute the transactions.

The sixth-summary-paragraph relies on the following:

- 1) Suer's Abstract;
- 2) ITEM A;
- 3) parts of ITEMS B, C, D, F;
- 4) all of ITEM H;
- 5) part of ITEM I; and
- 6) part of ITEM K.

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As to (1), Suer's Abstract only refers to **data transfer**. It does not state that **commands** are transmitted. Further, the Abstract does not discuss the claimed "wireless telephone."

As to the other ITEMS [ie, (2) through (6) in the list above], Appellant's summaries of those ITEMS given above indicates that those ITEMS in Suer do not support the PTO's sixth-summary-paragraph. Some reasons include the facts that

- Suer never discusses a functioning ATM which does not accept commands from a wireless device, followed by a functioning ATM which **does** accept such commands; and
- Suer does not discuss issuing commands using a wireless telephone.

SEVENTH SUMMARY PARAGRAPH

Point 1

The discussion above, relating to the sixth-summary-paragraph, applies to the seventh-summary-paragraph, which appears on page 3 of the Final Action, and begins with "a self-service terminal having been retrofitted . . . "

Point 2

In addition, the seventh-summary-paragraph, even if accurate, is irrelevant. It does not show the claims.

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In essence, this summary-paragraph asserts that Suer's ATM, prior to the modification, did not accept commands from a **wireless telephone**. Then, after the modification, the ATM accepts commands from a **source external to the terminal**.

Even if that is correct, it is irrelevant. The claims do not recite that.

Conclusion as to PTO's Summary-Paragraphs

Point 1

The seven summary-paragraphs, appearing in section 2 of the Final Action, are all incorrect. Even if not incorrect, many of them are irrelevant, in making assertions which are not related to the claims.

Point 2

Section 103 requires that the PTO show "the subject matter sought to be patented" "as a whole" to be obvious. The PTO's summary-paragraphs fail to fulfill this requirement.

These summary-paragraphs, at best, (1) select certain recitations from the claims and (2) assert that Suer shows the recitations.

But no summary-paragraph shows **the complete content** of any claim (subject to absent content supposedly found in the other reference, Terranova).

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Further, even if the summary-paragraphs be accepted as correct, other elements are claimed, and those elements have not been shown in the references.

For example, the PTO has never **asserted** that the following claim recitations are present in Suer, let alone provided an erroneous citation in support of the supposed claim recitation:

Claim 2 recites "retro-fitting an ATM with a" specific computer program.

No such program has been identified in the references, nor even erroneously asserted to be present in the references.

Claim 20 recites a "host" computer, which communicates with ATMs. Dependant claim 21 states that a program on the host, a program in the ATM, or both, is "upgraded."

No such upgrading has been identified in the references, nor even erroneously asserted to be present in the references.

The parent claims of claim 24 recite a "transceiver" installed into an ATM. Claim 24 states: "wherein the transceiver is assigned a telephone number, and the SST displays that telephone number to customers."

No such "telephone number" has been identified in the references, nor even erroneously asserted to be present in the references.

Dependent claim 30 states: "wherein the transceiver comprises an adapter card installable in a computer."

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No such "adapter card" has been identified in the references, nor even erroneously asserted to be present in the references.

Therefore, Appellant submits that the seven summary paragraphs given in the Final Action, pages 2 and 3, cannot be accepted. Without them, all rejections fail.

ADDITIONAL POINTS

The Summary of Argument given above is believed to rebut the rationale given for combining the references. In addition, Appellant makes the following points.

Rejection is Defective as Matter of Procedure

As a procedural matter, the rejection is defective. The rejection, in the seven paragraphs on pages 2 and 3 which are flagged by arrowheads, purports to find certain claim elements in the Suer reference.

However, even if those seven paragraphs are correct in fact, that procedure is insufficient. Every claim in its entirety must be shown in the prior art.

Merely setting out seven paragraphs which supposedly show some claim elements is insufficient.

Each and every claim must be shown in the references. That

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has not been done.

Claimed Change in Operation of ATM not Shown in References

Dependent claims 17 and 28 state that, prior to a claimed modification, a self-service terminal could not receive commands from a "wireless telephone," and that such a terminal is then modified in a specific way.

Those recitations are not found in the references.

Final Office Action is Self-Contradictory

The Final Action, page 3, asserts that Suer "fails to show a wireless phone to withdraw cash from an ATM."

On page 2, section 2, third paragraph (ie, the first arrowed paragraph), the Final Action states the opposite.

Contradictory assertions cannot be used.

Part of PTO's Rationale has not been Justified

As part of its reasoning that the invention is obvious, the Final Action, page 3, second full paragraph, states:

It is well known . . . to retrofit any controllable electronic device with a wireless transponder/receiver to control the device.

Appellant disputes the correctness of this assertion,

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traverses it, and requests that a reference be cited in support of the assertion. (See MPEP § 2144.03.)

One reason is that the assertion seems to be incorrect on its face. For example, the undersigned attorney owns a pocket calculator, which is a "controllable electronic device." Why is it well known to equip that calculator with a wireless remote control feature ?

As another example, consider an ordinary television, but one lacking remote control. Appellant submits that the height of absurdity would be attained by attempting to retro-fit this television with a remote control, for at least three reasons. One is that, since proprietary integrated circuits are so widely used, only the original manufacturer would know how to perform the retro-fit.

A second reason is that many of the required signal lines are buried within integrated circuits, and are not available. A third reason is that retro-fitting would be so expensive that purchasing a new TV equipped with a remote control is the more intelligent option.

Therefore, Appellant disputes the accuracy of the PTO's assertion, and requests justification.

Even if References Combined, Claims are not Attained

Several independent claims recite using a "wireless

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telephone" to cause an ATM to dispense cash. Neither reference shows a "wireless telephone."

Thus, even if the references are combined, the claimed "wireless telephone" is absent.

No Teaching Given for Selecting Wireless Aspect of Terranova

Terranova discusses a gasoline pump which dispenses cash, like an ATM. However, he discusses two modes of operation.

In one mode, the customer inserts a card having a magnetic stripe, in the usual manner. (Paragraphs 0026, 0031, and 0039.)

In another mode, the customer uses a wireless device. (Paragraphs 0028, 0029, and 0041.)

The PTO has given no rationale for selecting the wireless mode, as opposed to the normal mode, and using the wireless mode in its rationale for combining references.

Rationale for Combining References is Defective

Point 1

Appellant will re-phrase the rationale in more succinct terms, to facilitate analysis. The rationale is this:

It is obvious to equip an ATM lacking a wireless interface by using Suer's device as taught by Terranova.

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Several problems become immediately apparent.

PROBLEM 1

The rationale is completely arbitrary, and utterly conclusory. No reasoning has been given as to why equipping the ATM in the manner suggested proceeds as a matter of logic from Suer and Terranova.

PROBLEM 2

The rationale does not lead to the claimed invention. At best, the rationale leads to the conclusion that an ATM should be equipped with a "remote control communication system." (Final Action, page 3, last paragraph in section 2.) The claims do not recite that.

PROBLEM 3

The **combination** of references does not suggest that an ATM should be equipped with a "remote control communication system." Suer, by himself, suggests that. Thus, the combination of references does not lead to the conclusion.

Rationale For Combining References Fails to Comply with Section 103

The rationale for combining the references is given on page 3 of the Final Action, and states, in part:

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[It is obvious] to equip an ATM that [lacks]
. . . the remote control communication system
by using [S]uer's device to communicate via a
transponder/receiver as taught by Terranova
to conduct business wirelessly.

However, several problems exist in this rationale.

Problem 1

The rules require that the teachings of **each** reference be
identified. MPEP § 706.02(j) states:

Contents of a 35 U.S.C. 103 Rejection

. . .
After indicating that the rejection is under
35 U.S.C. 103, the examiner should set forth
in the Office action:

(A) the relevant teachings of the prior art
relied upon, preferably with reference to the
relevant column or page number(s) and line
number(s) where appropriate,

. . .

It is important for an examiner to properly
communicate the basis for a rejection so that
the issues can be identified early and the
applicant can be given fair opportunity to
reply.

The Final Action's statement fails to meet these
requirements.

-- The statement fails to **separately**
identify what **Suer teaches** and what **Terranova**

teaches.

That makes it impossible to identify the relevant issues, as required by this MPEP section. One issue is "What does Suer teach ?" The PTO has not answered this question. A similar question applies to Terranova.

Another problem in identifying relevant issues lies in the statement "[It is obvious to use] Suer's device . . . as taught by Terranova." This statement is ambiguous, and thus its truth cannot be verified.

-- Is it asserting that Terranova teaches
using Suer's device ?

-- Is it asserting that Terranova teaches
using a transponder, and that it is obvious
for Suer to use a transponder in a similar
manner ?

Until the ambiguity is resolved, the relevant issue cannot be identified, as required by this MPEP section.

Problem 2

A second problem is that the rationale does not follow the CAFC's decision of In re Dembiczak, 175 F. 3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999).

In brief, Dembiczak states that

-- **objective evidence** of a teaching for

combining references must be provided;

- the Examiner's speculation does not qualify as objective evidence;
- numerous sources can provide a teaching to combine references;
- knowledge of one skilled in the art can act as a source;
- however, THE RANGE OF SOURCES AVAILABLE DOES NOT DIMINISH THE REQUIREMENT FOR ACTUAL EVIDENCE;
- broad conclusory statements by the Examiner do not qualify as evidence; and
- "particular factual findings" as to the teaching are required, and gives reasons why **facts** are necessary.

Appellant submits that the PTO's rationale is a "broad conclusory statement" which is prohibited by Dembiczak.

Rationale for Combining References is Illogical

The rationale, in essence, asserts

- Terranova teaches that Suer should be used in a certain way, and
- This certain way makes it obvious to add a remote control to an ATM.

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But the conclusion does not follow from the argument. The argument is a non sequitur.

One reason is that Suer already shows using a remote control for an ATM. If Suer already shows something, then how does a teaching of Terranova suggest that Suer show that same thing ? The rationale is illogical.

Another reason is that Terranova, in fact, does not teach that Suer be used in a certain way. That assertion is a naked conclusion.

ARGUMENT REGARDING SPECIFIC CLAIMS

Claim 1

Claim 1 recites a wireless telephone. No wireless telephone has been shown in the applied references.

Claim 1 also recites an operating ATM which exists, and a modification of that ATM. No modification of an existing operating ATM has been shown in the applied references.

Claim 2

Claim 2 recites retro-fitting a program. That has not been shown in the applied references.

Claim 3

Claim 3 recites retro-fitting the ATM with a transceiver

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which receives signals directly from the wireless telephone.
That has not been shown in the applied references.

Claim 4

Claim 4 states that the transceiver sends signals to the wireless telephone. That has not been shown in the applied references.

Claim 5

Claim 5 stands or falls with its parent claim 4.

Claim 6

Claim 6 states that "said modifying step includes providing a connection between said network and said wireless telephone." That has not been shown in the applied references.

Claim 7

Claim 7 states "said modifying step includes: retrofitting said ATM with a transceiver adapted to receive signals directly from a wireless telephone; and providing a connection between said network and said wireless telephone." That has not been shown in the applied references.

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Claim 8

Claim 8 recites a wireless telephone. No wireless telephone has been shown in the applied references.

Claim 8 also recites an operating ATM which exists, and a modification of that ATM. No modification of an existing operating ATM has been shown in the applied references.

Claim 8 also states that the wireless telephone can be used to cause the ATM to dispense cash, without use of a touch pad on the ATM.

None of the preceding has been shown in the applied references.

Claim 15

Claim 15 recites an existing, operating SST, and modifying that SST so that it can receive commands from a wireless telephone.

None of that has been shown in the applied references.

Claim 16

Claim 16 recites:

16. A transceiver for installing in a self-service terminal (SST) during a **retrofit operation** of the SST, where the transceiver is operable to conduct wireless communication with a user of the SST, and the transceiver is adapted to convey transactions to the SST,

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so that when the transceiver is installed in the SST a user can execute a transaction on the SST using a wireless communication device.

"Retrofit" implies the previous existence of an SST which lacks the functionality added by the retrofitting. No such previous existence of an SST has been shown in the applied references.

Claim 17

Claim 17 recites:

17. A self-service terminal having been retrofitted to allow the terminal to execute transactions entered using a wireless telephone, wherein said terminal did not allow transactions to be entered using a wireless telephone prior to retrofitting.

"Said terminal" must refer to an operational terminal which exists prior to the retro-fitting operation, which operates as a terminal, but did not accept transactions from a wireless telephone. That has not been shown in the applied references.

Claim 17 also states that, after retro-fitting, transactions can be accepted from a wireless telephone. No wireless telephone has been shown in the applied references.

Claim 18

"Said terminal" must refer to an operational terminal which exists prior to the retro-fitting operation, which operates as a terminal, but did not accept transactions from the claimed "authorized source." That has not been shown in the applied references.

Claim 18 also states that, after retro-fitting, transactions can be accepted from the "authorized source." The non-acceptance, followed by the acceptance after retrofitting, have not been shown in the applied references.

Claim 19

Claim 19 recites modifying a program in a terminal during an upgrade. No such modification has been shown in the applied references.

Claim 19 also states that, prior to the upgrade, a certain functionality was lacking, but present after the upgrade. That has not been shown in the applied references.

Claim 20

Claim 20 recites: "modifying said system to enable at least one of said ATMs to receive from a wireless telephone user commands for dispensing cash." No wireless telephone has been shown in the applied references, nor the modification process.

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Further, claim 20 recites a plurality of ATMs existing prior to the modification. No such ATMs have been shown in the applied references.

Claim 21

Claim 21 states that the modifying includes upgrading a program. That has not been shown in the applied references.

Claim 22

Claim 22 states that, prior to the modification, the ATM could not receive certain commands from a wireless telephone. But its parent claim states that, after the modification, those certain commands could be received from a wireless telephone.

That combination of elements has not been shown in the applied references.

Claim 23

Claim 23 states that, prior to the modification, no ATMs could not receive certain commands from a wireless telephone. But its parent claim states that, after the modification, those certain commands could be received from a wireless telephone.

That combination of elements has not been shown in the applied references.

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Claim 24

Claim 24 states that the transceiver is connectable to a system bus. That has not been shown in the applied references.

Claim 25

Claim 25 states: "the transceiver is assigned a telephone number, and the SST displays that telephone number to customers." That has not been shown in the applied references.

Claim 26

Claim 26 states that, prior to the modification, the SST could not receive certain commands from a wireless telephone. But its parent claim states that, after the modification, those certain commands could be received from a wireless telephone.

That combination of elements has not been shown in the applied references.

Claim 27

Claim 27 states that, prior to the modification, the ATM could not receive certain signals from a wireless telephone. But its parent claim states that, after the modification, those certain signals could be received from a wireless telephone.

That combination of elements has not been shown in the applied references.

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Claim 28

Claim 28 states that, prior to the modification, the ATM could not receive certain signals from a wireless telephone. But its parent claim states that, after the modification, those certain signals could be received from a wireless telephone.

That combination of elements has not been shown in the applied references.

Claim 29

Claim 29 states that communication between the wireless telephone and the ATM occurs through the network. Suer is cited to show that, but the element relied on is Suer's infra-red transceiver.

That transceiver connects directly to a PC in the ATM, and thus does not go through the network as claimed.

Claim 30

Claim 30 recites an adapter card which comprises the transceiver. That has not been shown in the applied references.

Claim 31

Claim 31 states that the SSTs executed transactions prior to the installation of the transceiver. No SST which (1) executed

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transactions prior to installation of a transceiver and (2) utilized a transceiver later has been shown in the applied references.

Comment

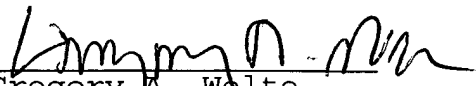
It has been stated that, for each claim, certain claim elements have not been shown in the applied references. The Final Action asserts that these elements do, in fact, appear in the applied references, especially in the Suer reference.

Appellant gave explanations above as to why these assertions are incorrect. Further, the Final Action's assertions themselves are insufficient. The Final Action must **show** the elements in the applied references. That has not been done.

CONCLUSION

Appellant requests that the Board overturn all rejections and pass all claims to issue.

Respectfully submitted,


Gregory A. Welte
Reg. No. 30,434

NCR Corporation
1700 South Patterson Blvd.
WHQ - 4
Dayton, OH 45479
(937) 445 - 4956
ATTACHMENT: APPENDIX OF APPEALED CLAIMS

NOV 8, 2004

9. APPENDIX

1. A method comprising: identifying an ATM which has a screen for displaying options for withdrawing cash and a touch input mechanism for receiving user commands; and modifying said ATM to enable it to receive from a wireless telephone user commands for dispensing cash.

2. The method of claim 1 wherein said modifying step includes retrofitting said ATM with a program for enabling said ATM to receive a transaction from a remote source.

3. The method of claim 1 wherein said modifying step includes retrofitting said ATM with a transceiver adapted to receive signals directly from the wireless telephone.

4. The method of claim 3, wherein said transceiver is further adapted to transmit signals directly to said wireless telephone.

5. The method of claim 4 wherein said signals implement local wireless communication.

6. The method of claim 1 wherein said ATM is connected to

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a network for communication therebetween, and wherein said modifying step includes providing a connection between said network and said wireless telephone.

7. The method of claim 1 wherein said ATM is connected to a network for communication therebetween, and wherein said modifying step includes: retrofitting said ATM with a transceiver adapted to receive signals directly from a wireless telephone; and providing a connection between said network and said wireless telephone.

8. A method comprising: identifying an ATM which has a screen for displaying options for withdrawing cash and a touch input mechanism for receiving user commands; and modifying said ATM to enable it to receive from a wireless telephone user commands for dispensing cash without the use of said touch input mechanism.

15. A method comprising the steps of: identifying a self-service terminal (SST) which has a screen for displaying user options and a touch input mechanism for receiving user commands; and modifying the SST so that it receives user commands from a wireless telephone.

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16. A transceiver for installing in a self-service terminal (SST) during a retrofit operation of the SST, where the transceiver is operable to conduct wireless communication with a user of the SST, and the transceiver is adapted to convey transactions to the SST, so that when the transceiver is installed in the SST a user can execute a transaction on the SST using a wireless communication device.

17. A self-service terminal having been retrofitted to allow the terminal to execute transactions entered using a wireless telephone, wherein said terminal did not allow transactions to be entered using a wireless telephone prior to retrofitting.

18. A self-service terminal having been retrofitted to receive a transaction from an authorized source external to the terminal, wherein said terminal was unable to receive transactions from said authorized source prior to retrofitting.

19. A self-service terminal including a program storage device, the device having been upgraded to encode a program of instructions for monitoring an external source and for receiving a transaction from an authorized source via the external source, wherein the terminal was unable to receive transactions via the

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external source prior to upgrading.

20. A method comprising: identifying a system which includes a host and a plurality of ATMs interconnected by a network in which each ATM has a screen for displaying options for withdrawing cash and a touch input mechanism for receiving user commands; and modifying said system to enable at least one of said ATMs to receive from a wireless telephone user commands for dispensing cash.

21. The method of claim 20 wherein said modifying step includes upgrading a program residing on said host, on at least one of said ATMs, or both.

22. Method according to claim 1, wherein, prior to the process of modifying said ATM, said ATM was incapable of receiving user commands for dispensing cash from a wireless telephone.

23. Method according to claim 20, wherein, prior to modifying, no ATMs could receive user commands for dispensing cash from a wireless telephone.

24. Apparatus according to claim 16, wherein the

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transceiver is connectable to a system bus of a computer within the SST.

25. Apparatus according to claim 24, wherein the transceiver is assigned a telephone number, and the SST displays that telephone number to customers.

26. Method according to claim 15, wherein the SST was unable to receive user commands from a wireless telephone prior to the modifying process.

27. Method according to claim 7, wherein said ATM was unable to receive signals directly from a wireless telephone prior to the modifying step.

28. Method according to claim 8, wherein said ATM was unable to receive signals directly from a wireless telephone prior to the modifying step.

29. Method according to claim 6, wherein communication between the wireless telephone and the ATM occurs through the network.

30. Apparatus according to claim 16, wherein the

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transceiver comprises an adapter card installable in a computer.

31. Apparatus according to claim 16, wherein the SSTs
executed transactions prior to installation of the transceiver.